



16-1

#8
8-16-02
R2

Atty. Dkt. No. 081356-0158

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kazuma Tomizuka *et al.*

Title: METHOD FOR MODIFYING
CHROMOSOMES

Appl. No.: 09/763,362 Filing Date: 04/23/2001

Examiner: Thaian N. Ton Art Unit: 1632

RECEIVED

AUG 14 2002

TECH CENTER 1600/2900

ELECTION UNDER 35 USC §121

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated July 9, 2002, applicants provisionally elect Group I, claims 1-25 and 84. Applicants traverse because they believe that claims 86-92, from Group V, should be examined with Group I.

The examiner contends that "Group[s] II-V recite distinct materials and/or method steps that are neither required nor recited in the...Group I" claims, and that the groups in question "lack the same or [a] corresponding technical feature" (page 3). Applicants submit, however, that the examiner has misjudged the nature of the technical *relationship* that illuminates technical features that are common to Groups I and V.

According to the relevant PTO rule, "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn" to, *inter alia*, a "product and process of use of said product." 37 CFR §1.475(b)(2). In the present instance, the Group I claims relate the use of "a targeting vector" to modify a "foreign chromosome," via "homologous recombination" (claim 1). The Group V claims are directed to just such a "targeting vector," which is comprised of a "sequence derived from a human chromosome," thus targeted thereto, and "a recognition sequence for a site-directed recombination enzyme" (claim 86).

The combined use of a targeting vector and a foreign chromosome (say, a human chromosome out of its normal setting) defines "a contribution which each of the claimed inventions" of these groups "makes over the prior art." 37 CFR §1.475(a). Accordingly, the Group I and Group V claims are "so linked as to form a single general inventive concept" (*id.*), fulfilling the requirement for unity of invention.

For this reason, Applicants request that the examiner remove the restriction as to Group V and consider claims 1-25, 84, and 86-92 in this prosecution. In any event, Applicants reserve the right to file a divisional application covering the subject matter of the non-elected claims. Receipt of the initial Office Action on the merits is awaited.

Respectfully submitted,

Date 9 August 2002
FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

By S. A. Bent

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768

